
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Heller et al.

Attorney Docket No.:
APL1P288/P3054US1

Application No.: 10/622,017

Examiner: Meucci, Michael D.

Filed: July 16, 2003

Group: 2142

Title: METHOD AND SYSTEM FOR DATA
SHARING BETWEEN APPLICATION
PROGRAMS

Confirmation No.: 1693

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant requests review of the final rejection in the above-identified application.

No amendments are being filed with this request.

This request is being filed with a Notice of Appeal. The review is requested for the reasons stated below.

Claims 1, 2, 4-9, 11-12, and 39 were rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Kent (The Complete Idiot's Guide to the Internet) in view of Groos III et al (U.S. 20030026446) and Steele et al. (U.S. 7,016,877). Applicant respectfully traverses the rejection.

Claim 1 describes a method for sharing media data between application programs including a step of "accessing, by a second application, a data communication file provided by the first application program, the first application program utilizing database data in a proprietary format not understood by the second application program, and the data communication file being derived from the database data such that data internal to the data communication file is acquired from the database data." The Examiner argues that Kent teaches accessing, by a second application program, a data communication file provided by a first application program. The Examiner further argues that Groos III teaches utilizing database data with the data

communication file being derived from the database data such that data internal to the data communication file is acquired from the database data. The Examiner further argues that Steele teaches that the data is of a proprietary format not understood by the second application program and that it would be obvious to combine Kent, Groos III, and Steele to teach the invention in claim 1.

The Examiner, however, has taken bits and pieces from three unrelated references and combined them together without any regard for the motivation to do so. Specifically with regard to the combination of Groos III and Steele, the Examiner argues that one would be motivated to combine these references to have “a convenient and secure system for automating the management of consumer information” (citing Steele). This quotation, however, comes from a different part of Steele than does the section relied upon to allegedly teach the elements of claim 1 (the use of data in a proprietary format not understood by the second application program).

Specifically, the Examiner points to lines 16-21 of column 2 of Steele as allegedly teaching the use of data in a proprietary format. These lines state: “[t]he data elements in such data file can be shared using specialized applications for filtering data out of the data file and into another application. However, such systems typically require a permanent download of proprietary data management software that might not be compatible among different devices.” Notably, this section of Steele is in the background section and describes the prior art, and the defects inherent in the prior art, namely that the use of proprietary data formats requires that each client application have specialized software in order to read the proprietary format.

The quotation used by the examiner as purported motivation to use this use of proprietary data formats as part of the rejection, on the other hand, comes from a different portion of the background section and in fact describes the motivation to create the invention in the detailed description section of Steele. In other words, the Examiner’s motivation identified from Steele in fact teaches away from the part of the Steele reference used to teach the elements of claim 1. The invention described in Steele in fact does not use proprietary data format, but rather solves the problem identified in the background section by creating a data repository that is accessible by many different clients, restricting access to various sections of the database using authentication information from the various client. The clients themselves are all able to read the database data once access is granted because the database data is NOT in a proprietary format (“The data in the information account is preferable stored using a tagged data format. In one embodiment, the data in the information account may be stored using the eXtensible Markup

Language ('XML') data format, which is an open standard for describing data from the World Wide Web Consortium ('W3C')." Col. 4, lines 56-61). In fact, there does not appear to be any application in the invention in Steele that could not read the stored information in the database, given the proper authentication. As such, the information cannot be said to be stored in a proprietary format not understood by the second application program.

Therefore, one of ordinary skill in the art would NOT be motivated to combine Groos III with Steele because Steele's proprietary format is in fact only described as an problematic feature of the prior art and the Examiner's purported motivation to combine relies on a section of Steele that actually indicates a desire to teach away from problematic proprietary format.

Furthermore, there is no motivation to combine Steele with Kent as it is unclear how one could do so and still arrive at an operable invention. The Examiner utilizes the FTP program described in Kent as allegedly teaching various elements of claim 1. Specifically, the Examiner argues that the FTP client program described on pages 267-268 of Kent is the second application program and the FTP host program is the first application program. The Examiner then argues that the directory sent from the FTP host to the FTP client (the "pub" directory on page 268) is the data communication file. This interpretation of Kent is of course necessary since the Examiner later wants to argue that the selection of an individual link in the returned directory amounts to receiving a user selection with respect to the user interface, identifying a media content file associated with the user selection, and associating a media content file identified by the user selection to the second application program. In other words, the directory itself is the data communication file and the linked file within the directory is the media content file. That interpretation may work for the elements in Kent, but it falls apart when combined with Steele.

The Examiner relies upon the combination of Steele with Kent to teach that the data communication file is in a proprietary format not understandable by the second application program. However, such a combination would then mean that the directory in Kent is in a proprietary format (not the media file). It is unclear how a directory in an FTP program could possibly be in a proprietary format not readable to an FTP client. While one could perhaps imagine that an underlying file linked to by a link in a directory is stored in a proprietary format, to have the directory itself in a proprietary format not readable by the client makes no sense. Unfortunately, the Examiner has elected to make a correspondence between elements in Kent and claim 1 that makes it impossible for Steele to be utilized in the manner so prescribed. As such, one of ordinary skill in the art would NOT be motivated to combine Steele with Kent.

As such, Applicant respectfully submits that claim 1 is in condition for allowance.

Claims 10 and 41 were rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Kent (The Complete Idiot's Guide to the Internet) in view of Groos III et al (U.S. 20030026446) and Steele et al. (U.S. 7,016,877), and further in view of Book (U.S. 2003/0223566).

Claim 42 was rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Kent (The Complete Idiot's Guide to the Internet) in view of Groos III et al (U.S. 20030026446) and Steele et al. (U.S. 7,016,877), and further in view of Book (U.S. 2003/0223566), and further in view of Carter (US. 5,987,506).

Claims 3, 13-14, and 40 were rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Kent (The Complete Idiot's Guide to the Internet) in view of Groos III et al (U.S. 20030026446) and further in view of Griner (U.S. 6,614,729).

Claims 15, 17-19, 21-22, and 26 were rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Kent (The Complete Idiot's Guide to the Internet) in view of Carter and Steele.

Claims 16, and 23-25 were rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Kent (The Complete Idiot's Guide to the Internet) in view of Carter and Griner.

Claims 10 and 20 were rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Kent (The Complete Idiot's Guide to the Internet) in view of Carter and Steele and further in view of Book.

Claims 27-31, 33-35 were rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Kent (The Complete Idiot's Guide to the Internet) in view of Griner and Steele.

Claim 32 was rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Kent (The Complete Idiot's Guide to the Internet) in view of Griner and Steele and further in view of Book.

Claims 36 and 37 were rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Kent (The Complete Idiot's Guide to the Internet) in view of Griner and Steele and further in view of Kronick (Netscape Navigator).

Claim 38 was rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Kent (The Complete Idiot's Guide to the Internet) in view of Griner and Steele and further in view of Buswell (U.S. 6,836,885).

Independent claims 15 and 27 contain elements similar to that as described above with respect to claim 1. As such, Applicant respectfully submits that these claims are allowable for the same reasons as described above with respect to claim 1.

Dependent claims 2-14, 16-26 and 28-42 each depend directly from independent claims described above, and are therefore respectfully submitted to be patentable over the art of record. Further, the dependent claims recite additional elements which when taken in the context of the claimed invention further patentably distinguish the art of record.

Withdrawal of the rejections under 35 USC §103(a) is therefore respectfully requested.

I am the attorney or agent acting under 37 CFR 1.34

Respectfully submitted,
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